

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of

WONG et al.

Atty. Ref.: JSP -4593-182

Serial No. 09/741,684

TC/A.U.: 2627

Filed: December 18, 2000

Examiner: Brian E. Miller

For: BONDING PAD OF SUSPENSION CIRCUIT

* * * * *

(January 23, 2010 = Saturday)

(January 24, 2010 = Sunday)

January 25, 2010 (= Monday)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

In response to the Examiner's Answer dated November 23, 2009, Applicant now submits the following Reply Brief pursuant to 37 C.F.R. § 41.41.

This is in response to the Examiner's Answer dated November 23, 2009. The arguments set forth in the Appeal Brief dated August 24, 2009 are incorporated herein by reference, and Applicant will not repeat the same herein. The following arguments are presented in response to the new arguments presented in the Examiner's Answer (e.g., see the "Response to Arguments" section on pages 5-6 of the Examiner's Answer) and also further clarify Applicant's previous positions.

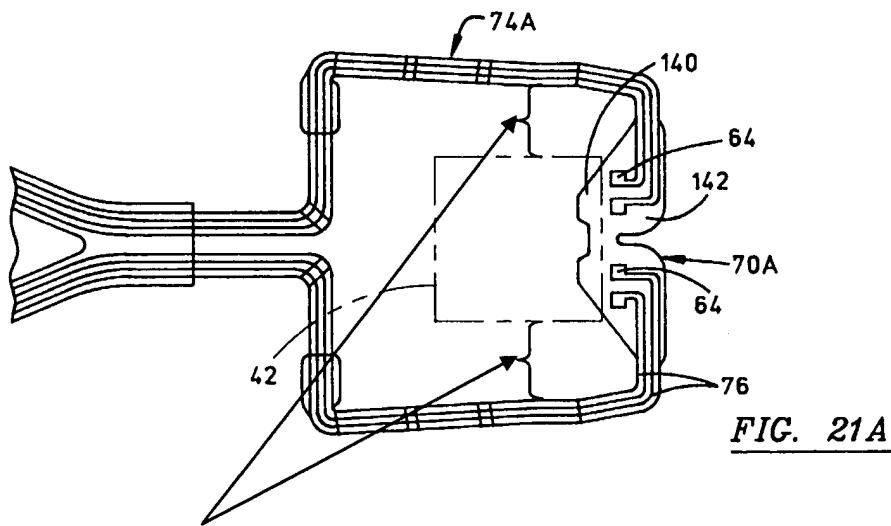
Applicant notes with appreciation the indication that the previous rejections under 35 U.S.C. § 112, first and second paragraphs have been withdrawn. Applicant also notes with appreciation the clarification regarding the ground under which claim 24 is rejected. The following brief comments are directed to the outstanding §§ 102 and 103 rejections.

First, claims 19-23 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated over Albrecht et al. (U.S. Patent No. 5,821,494). A § 102 rejection is only appropriate where a single reference discloses the identical invention in as much detail as called for in the claims. Because Albrecht does not identically disclose the subject matter of claim 19, it cannot anticipate this claim (or its dependents) as a matter of law.

The Examiner relies on Figs. 21A, 21B, and 21C, as well as col. 9, lines 10-53 of Albrecht, as allegedly disclosing "a plurality of traces extend[ing] longitudinally generally along the center of a suspension and suspend along the lateral edges of a slider to a trailing edge of the slider." But as can be clearly seen from the relied-on figures of Albrecht, the traces extend around the slider 42. They do not extend along the lateral edges of the slider. In other words, the traces are spaced apart from the lateral edges of the slider. There clearly is a distance between the traces and the outer lateral edges of the

slider, such that the traces do not extend along the lateral edges of the slider. Although the traces of Albrecht may be said to be "around" the lateral edges of the slider, one of ordinary skill in the art would not consider the traces to extend "along" the lateral edges of the slider.

The difference between "around" and "along" is perhaps best demonstrated by the representative drawings below taken from Albrecht and the instant application:



Albrecht: Traces "around" lateral edges of slider

Instant Application: Traces “along” lateral edges of slider

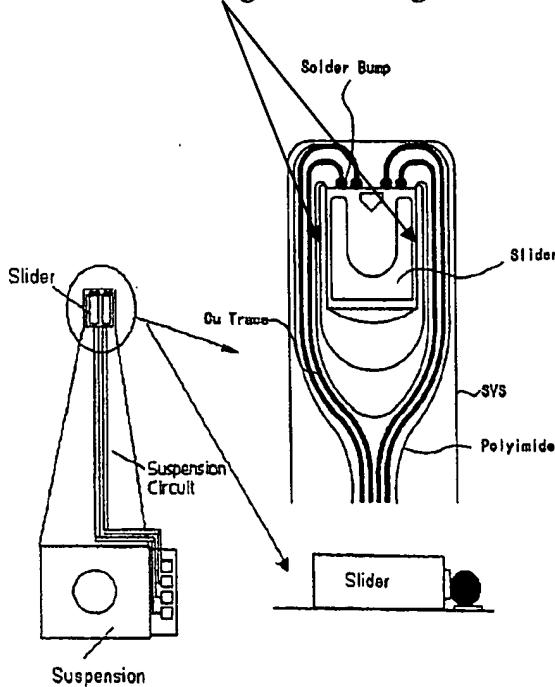


Figure 1

The terms “around” and “along” may be similar to one another, but they certainly are not identical in scope or meaning. As such, Applicant respectfully submits that Albrecht does not identically disclose the invention of claim 19 in as much detail as recited in the claim. Thus, Applicant respectfully submits that Albrecht does not anticipate claim 19 (or its dependents).

Second, claim 24 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Albrecht. With respect to the rejection of claim 24, Applicant respectfully points out that the Examiner has merely indicated that one of ordinary skill in the art at the time of the invention would have arrived at the specifically claimed height and diameter values via routine experimentation and/or optimization. But the Examiner has not established that these dimensions are outcome effective variables. Without this

preliminary showing, the legal conclusion of obviousness based on “routine experimentation and optimization” cannot be supported. Quite the contrary, the MPEP makes clear that the mere fact that particular elements could be rearranged or modified does not mean that it would have been obvious to have done so by one of ordinary skill in the art at the time of the invention. Here, absent some showing of outcome effectiveness, there would have been no motivation for one of ordinary skill in the art at the time of the invention to have modified Albrecht to obtain the specifically claimed height and diameter values of claim 24. Again, without this preliminary showing, the Examiner’s motivation for making the modification cannot stand. Thus, the burden to rebut any showing of obviousness has not shifted to Applicant, as the Examiner has not yet established a *prima facie* case of obviousness. The outstanding § 103 rejection is flawed at least because the Examiner has not made the appropriate foundational showings.

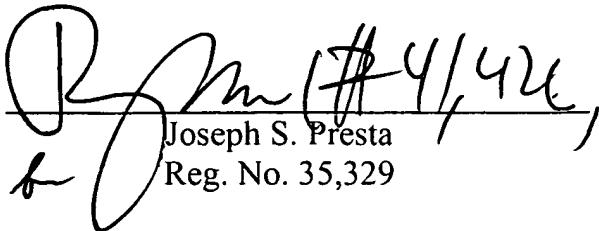
Conclusion

The application is in clear condition for allowance, and early reversal of the Final Rejection and passage of the subject application to issue thus are earnestly solicited.

Respectfully submitted,

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